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Practitioner's Docket No. 61632 (1062.013)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: McLeod et al.

Group Art Unit: 3726

Serial No.: 10/081,506

Examiner: Essama Omgba

Filed: February 22, 2002

For: AUTOMOTIVE ROOF MODULE AND METHOD OF ASSEMBLY OF THE
MODULE TO AN AUTOMOTIVE VEHICLE

Attorney Docket No.: 61632 (1062.013)

Mail Stop Appeal Brief-Patents
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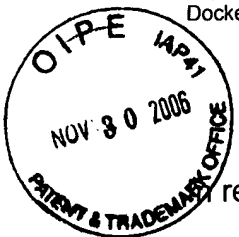
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REPLY BRIEF

In response to the Examiner's Answer mailed October 19, 2006, please consider
Appellant's rebuttal arguments.

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A. STATUS OF CLAIMS

The status of claims are the same as recited in the Appeal Brief.

B. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Grounds of Rejection are the same as recited in the Appeal Brief.

C. ARGUMENTS IN RESPONSE TO EXAMINER'S ANSWER

The Examiner's Answer still points to no particular motivation for combining Lumpe et al. with Hill et al. or any teaching, suggestion or motivation in the prior art or knowledge of the skilled artisan for arriving at the arrangements of claims 9, 14 and 17 of the present application. Instead, the Examiner's Answer asserts that "Lumpe et al. is merely a teaching reference...that shows that the use of the different pillars is well known in the art", (emphasis added), and that "provision of any particular pillars to a vehicle body will depend on the particular model, size or body type being manufacture." (emphasis added) The Answer then, based on these assertions, then makes the conclusory statement that, "it is within the general knowledge of one of ordinary skill in the art to assess the need for A, B or C-pillars and appropriately provide them, if needed, to the body of the vehicle being manufactured."

These assertions and statements in the Examiner's Answer do not provide any motivation, teaching or suggestion in the prior art or the ordinary knowledge of the skilled artisan to create the specific arrangements of claims 9, 14 and 17 (e.g., arrangement of a roof module with A-pillars and a windshield where the module is attached to a body of a vehicle already having B and/or C pillars). The Answer merely suggests, in a conclusory statement, that it is within the knowledge of one of ordinary skill to assess the need for vehicle pillars. Appellant contends that Lumpe et al. is not sufficient evidence to support this conclusory statement, however, even if it were sufficient, neither Lumpe et al. nor the asserted conclusory statement actually provide a motivation, teaching or suggestion toward the arrangement of claims 9, 14 and 17. At best, the conclusory statement suggests that the skilled artisan may have some degree of experience in manipulating vehicle pillars. This is not a motivation teaching or suggestion and, as the cited caselaw suggests, this motivation teaching or suggestion must be presented as a protection against impermissible hindsight. Moreover, Appellant points out that the statement in the Examiner's Answer shows that, to arrive at the arrangements of claims 9, 14 and 17, a great deal of modification of prior art is

required and such modification is being deemed obvious without any motivation, teaching or suggestion that is providing a connection between the prior art and those arrangements.

Suggestions, within the Examiner's Answer, that the rejections of claims 9, 14 and 17 are not based on impermissible hindsight lack merit. In particular, the law requires that there be a motivation, teaching or suggestion in the prior art or knowledge of the skilled artisan to combine references or other knowledge or information to protect against impermissible hindsight. The conclusory statement in the Examiner's Answer that "A, B, or C-pillars are old and well known in the art and the use of such pillar with a roof module is well within the general knowledge of one of ordinary skill in the art", shows that the rejections of claims 9, 14 and 17 are based upon impermissible hindsight. If the claim rejections were based upon a proper motivation, suggestion or teaching in the prior art or knowledge of the skilled artisan, the Examiner's Answer could point to such motivation, suggestion or teaching as evidence that the rejections are not based upon impermissible hindsight. However, the conclusory statement provided in the Answer does not even suggest that the prior art or the knowledge of the skilled artisan suggests the particular arrangements of claims 9, 14 and 17, rather, it merely suggests that vehicle pillars are known and that, on that basis, use of those pillars with a roof module is within the knowledge of the skilled artisan. Applicants contend that the rejections formulated in this manner to reject claims 9, 14 and 17 are based upon impermissible hindsight.

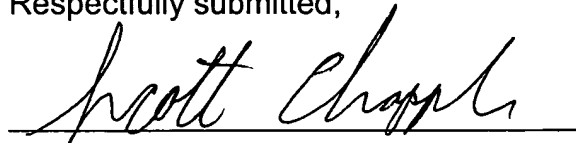
The Examiner's Answer suggests, "the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis of patentability when the differences would otherwise be obvious." However, Appellant contends that, as suggested above, the prior art does not suggest the arrangements of claim 9, 14 and 17 and that the advantages discussed by Appellant are advantages brought about by the inventive arrangements of claims 9, 14

and 17 that further illustrate the distinctions between those arrangements and the prior art.

The Examiner's Answer still provides no motivation for combining Bhat et al. with the other references of record for using an adhesive with elongation greater than 300%. The Answer reads "the fact that in Appellant's invention the transparent panel (windshield) is already part of a roof module at the time of the adhesive connection is inconsequential." (emphasis added) This statement in the Answer is contrary to the law cited in the Appeal Brief, which requires consideration of all of the limitations within the claims and requires consideration of the inventions within the claims "as a whole". The statement suggests that the Examiner believes language and/or limitations in Appellants claims is inconsequential. The Answer still provides no specific motivation for using the particular adhesive with the roof module as that module is recited in claims 9, 14 and 17.

Dated: 30 November, 2006

Respectfully submitted,

A handwritten signature in cursive script, reading "Scott Chapple", written over a horizontal line.

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